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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,790	02/25/2004	Hironori Kobayashi	CU-3608	3721
26530 7590 12/19/2008 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604			EXAMINER ANDERSON, JAMES D	
			ART UNIT 1614	PAPER NUMBER
			MAIL DATE 12/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,790

Applicant(s)

KOBAYASHI, HIRONORI

Examiner

JAMES D. ANDERSON

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 22-27 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Formal Matters

Claims 5 and 22-27 are pending and under examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/23/2008 has been entered.

Claim Objections

Claim 5 is objected to because of the following informalities: in line 1 of claim 5 Applicants recite "A method of producing a coating solution *for solution* for forming a wettability-varied pattern....". Recitation of "for solution" appears to be redundant because the preamble of the claim already recites production of a coating solution. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the formula "...Si_nO_{n-1}(OR)_{2n+2}, wherein R represents an alkyl group...". The metes and bounds of the chemicals defined by this formula are not clear because Applicant does not define the limits of "n" in the claim for this formula. While "n" appears to be defined for the formula Y_nSiX_(4-n), it is not apparent that this definition of n (*i.e.*, 0 to 3) applies also to the formula Si_nO_{n-1}(OR)_{2n+2}.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 22-27 are again rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kobayashi et al.** (EP 0 932 081 A1; Published July 28, 1999) (cited by Applicant in IDS filed 4/12/2007) in view of **Yoichi et al.** (JP 2000-053421; Published February 22, 2000) (cited by Applicant in IDS filed 4/12/2007).¹

The claims are drawn to a method of producing a coating solution for forming a wettability-varied pattern, comprising mixing a neutral solution of titanium oxide, which contains titanium oxide and an alkyl silicate having the formula $\text{Si}_n\text{O}_{n-1}(\text{OR})_{2n+2}$, wherein R is an alkyl group, with a solution of hydrolyzed fluoroalkylsilane having the formula $\text{Y}_n\text{SiX}_{(4-n)}$, wherein Y is a fluoroalkyl group, X is alkoxy, acetyl, or halogen, and n is 0 to 3, and wherein the pH of the coating solution is in a range of 5 to 9.

Kobayashi et al. teach methods of varying the wettability of layers on a substrate comprising applying a photocatalyst material (page 31, ¶ [0286]). The photocatalyst material is preferably titanium oxide (page 31, ¶ [0288]). The photocatalyst-containing layer may also contain a binder, preferably the instantly claimed polysiloxane containing a fluoroalkyl group, specifically hydrolysis condensates of fluoroalkylsilanes (page 32, ¶ [0295]). It is noted that the polysiloxanes containing fluoroalkyl groups listed on pages 32-33 meet the limitations of the claimed hydrolyzed fluoroalkylsilanes (e.g., $\text{CF}_3(\text{CF}_2)_3\text{CH}_2\text{CH}_2\text{Si}(\text{OCH}_3)_3$). In fact, Kobayashi explicitly teaches organopolysiloxanes composed mainly of a hydrolysis condensate of compounds represented by formula $\text{Y}_n\text{SiX}_{(4-n)}$, wherein Y is an alkyl, fluoroalkyl, vinyl, amino, or epoxy group, X is methoxy, ethoxy, acetyl, or halogen, and n is 1 to 3 ([0293]). Kobayashi teaches that the use of polysiloxanes containing fluoroalkyl groups as binders results in markedly

¹ A machine translation of Yoichi was provided with the previous Office Action

improved water repellency and oil repellency of the photocatalyst-containing layer (page 33, ¶ [0296]).

With respect to mixing a solution of titanium oxide and fluoroalkylsilicate as recited in claim 5, Kobayashi teaches that the photocatalyst (e.g., titanium oxide) and binder (e.g., fluoroalkylsilicate) are “dispersed in a solvent to prepare a coating liquid” ([0332]).

The Kobayashi *et al.* reference does not teach a solution of titanium dioxide containing an alkyl silicate or that the solution is at a neutral pH.

However, Yoichi *et al.* teach methods of preparing a titanium oxide solution having superior dispersibility in a neutral pH range for use as a photocatalyst, a catalyst, catalyst support, adsorbent, an ultraviolet ray absorbent, paint, or bulking agent (Abstract). A titanium oxide solution is mixed with an alkyl silicate as a dispersion stabilizer and the resultant mixture is neutralized to prepare the objective titanium oxide solution (*id.*).

With respect to the claimed alkyl silicates, Yoichi teaches alkyl silicates having the same structure as those claimed ([0009] of provided machine translation).

With respect to the pH of 5 to 9 as recited in claim 5 and the claimed weight ratio of 0.7 to 10 as recited in claim 24, Yoichi teach the same pH range and weight ratio as claimed (Abstract; [0006] of provided machine translation).

With respect to diluting with a hydrophilic solvent as recited in claims 26 and 27, Yoichi teaches that the titanium oxide sol and/or the alkyl silicate of the invention can be blended with a hydrophilic solvent and still maintain excellent dispersion stability ([0010] and [0014] of provided machine translation).

The titanium oxide/alkyl silicate solutions taught in Yoichi are further taught to be useful as photocatalysts as also taught by Kobayashi *et al.* ([0019] of provided machine translation).

Yoichi does not teach adding a fluoroalkyl silane to the titanium oxide/alkyl silicate solutions taught therein.

However, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to apply the technique of mixing titanium oxide and an alkyl silicate at a neutral pH as taught in Yoichi *et al.*, to improve the dispersibility of the titanium oxide in the fluoralkylsilane-containing solutions of Kobayashi *et al.* The resulting coating solution would predictably have increased dispersibility at a neutral pH, which would clearly aid

in applying said containing coating solutions to a substrate so as to induce varied wettability as taught in Kobayashi *et al.*

With respect to the pH of the solution of hydrolyzed fluoroalkylsilane solution (*i.e.*, 2 to 7) as recited in claim 22, Yoichi teach solutions of titanium oxide and alkyl silicates having a final pH of 5 to 9. As such, it would be obvious to adjust the pH of the fluoralkylsilane solution such that addition of this solution to the titanium oxide and alkyl silicate solution of Yoichi would result in a final solution having a pH of 5 to 9.

With respect to the ratio of neutral sol solution of titanium oxide to the solution of hydrolyzed fluoralkylsilane as recited in claim 23, no unobviousness is seen in varying the ratio of these solutions. While Kobayashi does not explicitly teach a ratio of titanium oxide to fluoralkylsilane, the reference does teach that the photocatalyst (*e.g.*, titanium oxide) in the photocatalyst-containing layer is preferably 5 to 60% by weight, more preferably 20 to 40% by weight ([0291]). Accordingly, it would have been obvious to add a binder such as a fluoralkylsilane as taught in Kobayashi in a range of 95 to 40% by weight, more preferably 80 to 60% by weight (*i.e.*, the remaining weight percentage), which amount falls within the ratio of 1:0.1 to 1 as recited in claim 23 (titanium oxide:fluoralkylsilane). It is noted that Example C-1 of Kobayashi provides a solution comprising 2 g of an inorganic coating composition for a photocatalyst and 0.3 g of a fluoroalkylsilane, *i.e.*, a ratio of 1:0.15 ([0562], and Example D-1 of Kobayashi provides a solution comprising 2 g titanium oxide and 0.15 g of a fluoroalkylsilane, *i.e.*, a ratio of 1:0.075 ([0595]).

Applicant's arguments have been carefully considered but they are not persuasive. Applicant believes the basis for the present rejection is incorrect because the two cited references do not combine to achieve the "desired result". However, it is unclear to the Examiner how this can be the case when Kobayashi explicitly suggests methods of varying the wettability of layers on a substrate comprising applying a photocatalyst material (page 31, ¶ [0286]), wherein the photocatalyst material is preferably titanium oxide (page 31, ¶ [0288]), and wherein the photocatalyst-containing layer also contains a binder, preferably the instantly claimed polysiloxane containing a fluoroalkyl group, specifically hydrolysis condensates of fluoroalkylsilanes (page 32, ¶ [0295]). As such, the Examiner is not persuaded that by mixing an alkyl silicate with titanium dioxide as taught by Yoichi so as to improve the dispersability of

titanium dioxide, the “desired result” of varying the wettability of layers on a substrate as taught in Kobayashi will not be achieved. Applicant has presented no factual evidence to support this assertion.

Applicant further argues that the reason why titanium oxide has excellent dispersibility in the titanium oxide sol of Yoishi is because alkyl silicate stabilizes the dispersibility of titanium dioxide during the hydrolyzation process. Applicant thus argues that even if the titanium oxide sol, where the alkyl silicate is contained as a hydrolyzed state, is added to the composition of Kobayashi, the dispersibility of titanium oxide could not be improved because alkyl silicate is hydrolyzed prior to its addition to the composition (i.e., adding alkyl silicate that is already hydrolyzed would not improve the dispersibility of the Kobayashi reference). This is not found persuasive because the claimed method steps simply require mixing two solutions: 1) a neutral sol solution of titanium dioxide which contains titanium oxide and an alkyl silicate having the formula $\text{Si}_n\text{O}_{n-1}(\text{OR})_{2n-2}$, wherein R is an alkyl group (as taught in Yoishi) and 2) a solution of hydrolyzed fluoroalkylsilane having the formula $\text{Y}_n\text{SiX}_{(4-n)}$, wherein Y is a fluoroalkyl group, X is alkoxy, acetyl, or halogen, and n is 0 to 3 (as taught in Kobayashi). Given the fact that both Kobayashi and Yoichi teach the use of titanium dioxide as a photocatalyst, the Examiner is not persuaded that the state of hydrolysis of the alkyl silicate taught in Yoishi has any bearing on the obviousness of the claimed coating solutions. In fact, Yoishi explicitly teaches that the titanium oxide sol solutions prepared by mixing titanium dioxide and the claimed alkyl silicates are especially useful as photocatalysts ([0019] of machine translation provided 3/25/2008). Further, Applicant is not claiming improved dispersibility of the claimed coating solution.

Applicant further argues that a person having skill in the art would not be motivated to combine the references because of “issues surrounding the pH” of the Kobayashi reference. In this regard, Applicant argues that although the exact pH of the composition taught by Kobayashi is not known, the addition of a composition having either neutral pH or an acidic or alkaline pH would negate any motivation. Applicant asserts that should the composition be neutral, the dispersibility of titanium dioxide would not be improved even if the titanium oxide sol of Yoishi is added thereto. This is not found persuasive because Yoishi already teaches that the titanium oxide sol solution is at a neutral pH. As such, it is not clear to the Examiner how adding a neutral solution to another neutral solution would have any adverse effect on the dispersibility of

titanium oxide. Further, as discussed supra, Applicant is not claiming improved dispersibility of titanium oxide. Kobayashi teach solutions for forming wettability-varied patterns comprising titanium dioxide as a photocatalyst and the claimed hydrolyzed fluoroalkylsilanes. The skilled artisan would reasonably expect that a titanium dioxide sol solution produced by the method of Yoishi would also be effective as a photocatalyst in the solutions taught in Kobayashi. In fact, Yoishi explicitly teach this use of the titanium oxide sol solutions disclosed therein.

Accordingly, the claims are deemed properly rejected for the reasons of record and as reiterated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. ANDERSON whose telephone number is (571)272-9038. The examiner can normally be reached on MON-FRI 9:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James D Anderson/
Examiner, Art Unit 1614